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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/030,222	04/01/2002	Norbert Kohler	612.41024X00	9212

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EXAMINER

RHEE, JANE J

ART UNIT	PAPER NUMBER
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1745

DATE MAILED: 03/18/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/030,222

Applicant(s)

KOHLER ET AL.

Examiner

Jane Rhee

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 10 August 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-11 and 21-30 is/are pending in the application.
- 4a) Of the above claim(s) 24-30 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-11, 21-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Rejections Repeated***

1. The 35 U.S.C. 103(a) rejection of claims 1-2,5-8,10-11,21-23 over Maxson in view of Biby et al. has been repeated for the reasons previously made in 5/10/2004.
2. The 35 U.S.C. 103(a) rejection of claims 1,3-4,9 over Maxson in view of Boehmer et al. has been repeated for the reasons previously made in 5/10/2004.
3. The 35 U.S.C. 103(a) rejection of claims 7,8 over Maxson in view Boehmer et al. and in further view of applicant's admitted prior art has been repeated for the reasons previously made in 5/10/2004.

### ***Election/Restrictions***

4. Newly submitted claims 24-30 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: The new submitted claims are directed to a string of tubings wherein the originally claimed invention are directed to a method intended for thermal insulation and an installation.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claims 24-30 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

### ***Response to Arguments***

5. Applicant's arguments filed 8/10/2004 have been fully considered but they are not persuasive.

Applicant argues that Maxson teaches away from the use of particles, especially vegetable foam particles for thermal insulation. Applicant claims in claims 1, "a method intended for thermal insulation *comprising* filling a volume defined by the space contained between a first enclosure interior to a second enclosure with vegetable foam particles" and in claim 7, "an installation that *comprises* a first enclosure placed in a second enclosure, characterized in that the space contained between the enclosures *comprises* a volume of vegetable foam particles used as a thermal insulant", wherein both of the independent claims use the terms "comprising" and "comprises" to describe an open ended invention, thus, the teaching of Maxson's particles embedded in resin reads on the independent claims since the open ended term "comprising" and "comprises" allows additional limitations to be added.

Applicant argues that the insulation material disclosed by Maxson is resistant to water absorption which teaches away from the use of vegetable foam particles which are not water absorption. Biby et al. not Maxon teaches vegetable foam that comprises at least flour (col. 4 line 47), plasticizer (col. 4 line 48), another additive (col. 4 line 49), a water content below 10% preferably below 5% (col. 4 line 50), and silicate particles (col. 6 line 53) for the purpose of being able to be disposed in a wastewater treatment system having facilities for biological or other types of degradative treatment (col. 2 lines 50-55). Furthermore, Biby et al. teaches that the foam is water resistant, therefore, does not teach away from the use of vegetable foam particles which are not water absorption.

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In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Maxson teaches a pipe jacket comprising a volume defined by the space contained between a first enclosure interior to a second enclosure is filled with foam particles (figure 2 number 18) which would sink to the bottom of a body of water and Biby et al. vegetable foam that comprises at least flour (col. 4 line 47), plasticizer (col. 4 line 48), another additive (col. 4 line 49), a water content below 10% preferably below 5% (col. 4 line 50), and silicate particles (col. 6 line 53) for the purpose of being able to be disposed in a wastewater treatment system having facilities for biological or other types of degradative treatment (col. 2 lines 50-55). Both foam particles disclosed by both references seek to provide water resistant foam to be used in a body of water. The motivation to combine Biby's vegetable foam to Maxson's pipejacket is to provide an environmental friendly foam that is biodegradable (col. 1 lines 42).

In response to applicant's argument that there is no suggestion to combine the references, the examiner recognizes that obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention where there is some teaching, suggestion, or motivation to do so found either in the

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references themselves or in the knowledge generally available to one of ordinary skill in the art. See *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992). In this case, Maxson teaches a pipe jacket comprising a volume defined by the space contained between a first enclosure interior to a second enclosure is filled with foam particles (figure 2 number 18) which would sink to the bottom of a body of water and Boehmer et al. teaches expanded vegetable foam material is solublized by an aqueous fluid (col. 1 lines 49) for the purpose of being able to be placed on the subsurface layer of a landfill or to be disposed in a wastewater treatment system having facilities for biological or other types of degradative treatment (col. 2 lines 50-55). The motivation to combine Boehmer et al.'s vegetable foam to Maxson's pipejacket is to provide an environmental friendly foam that is biodegradable (col. 2 line 31).

In response to applicant's argument that it is not common to use vegetable foam materials as a thermal insulant in the space contained between enclosures in general or enclosures which consist of string of tubing intended for transportation of a petroleum effluent, Maxson in view of Boehmer et al. teaches that it would have been obvious to one having ordinary skill in the art at the time applicant's invention was made to provide Maxson with vegetable foam material in order to be disposed in a wastewater treatment system having facilities for biological or other types of degradative treatment (col. 2 lines 50-55) as taught by Boehmer et al. and applicant's admitted prior art teaches that it is common to have a whole string of production tubing during production of a well for servicing operations on downhole equipments or installations (page 2 of specification

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line 9-12). Therefore, the combination of Maxson in view of Boehmer et al. and in further view of applicant's admitted prior art teaches that it would have been obvious to use vegetable foam materials as a thermal insulant in the space contained between enclosures in general or enclosures which consist of string of tubing intended for transportation of a petroleum effluent.

### ***Conclusion***

**THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jane Rhee whose telephone number is 571-272-1499. The examiner can normally be reached on M-F 9-6.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Patrick Ryan can be reached on 571-272-1292. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Jane Rhee  
March 9, 2005



**PATRICK JOSEPH RYAN**  
**SUPERVISORY PATENT EXAMINER**